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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/916,116	07/26/2001	Bruce E. Price	RGP-0062	8624
23413	7590	11/25/2003	EXAMINER	
CANTOR COLBURN, LLP				
55 GRIFFIN ROAD SOUTH				
BLOOMFIELD, CT 06002				
			CHANG, VICTOR S	
			ART UNIT	PAPER NUMBER
			1771	

DATE MAILED: 11/25/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/916,116

Applicant(s)

PRICE ET AL.

Examiner

Victor S Chang

Art Unit

1771

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 06 August 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-19 and 34-37 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-19 and 34-37 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

### Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) \_\_\_\_\_
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

1. The Examiner has carefully considered Applicants' amendments and remarks filed on 8/6/2003 and 9/10/2003. Applicants' amendments to the Specification and add new claims 34-37 has been entered. However, it is noted that Applicants' complete text of pending claims filed 9/10/2003 contains claims 20-33 as "withdrawn" is incorrect. The Examiner would like to remind Applicants that claims 20-33 have been previously cancelled (see Amendment dated 1/27/2003).
2. The text of those sections of Title 35, U.S. Code not included in this action can be found in a prior Office action.
3. Rejections not maintained are withdrawn.

### ***Response to Amendment***

4. Claims 1-19 and 34-37 are rejected under 35 U.S.C. 103(a) as being unpatentable over Applicants' admission either individually, or in view of Birchall et al. (US 3839078), substantially for the reasons set forth in section 3 of Paper No. 10, together with the following additional observations.

With respect to Applicants' response arguing that "Given the problem to be solved was failure of the reinforcing film, and not the strength of the bond between the reinforcing film and the polyurethane foam, use of an anchoring layer between the film and the foam is unobvious." (Remarks, page 12, second paragraph), the Examiner repeats (see Paper No. 10, pages 2-3, bridging paragraph) that Birchall teaches that it

has been a common practice to coat a surface of a film substrate with one or more adhesion promoting layers which adhere to the film substrate and to which the superstrate readily adheres. Such intermediate coating layers are often referred to as 'anchor' coatings and are derived, for example, from an isocyanate-ended polyurethane resin, a phenol-formaldehyde resin or a vinylidene chloride - alkyl acrylate copolymer resin (column 22, lines 5 to 14). As such, it would have been obvious to one of ordinary skill in the art to modify Applicants' admitted prior arts with an anchor layer, such as a polyvinylidene chloride layer, between the reinforcing film substrate and the polyurethane foam layer, motivated by the desire to improve the adhesion between the laminate layers (see page 4 of Paper No. 6).

With respect to Applicants' argument that "Birchall therefore do not provide any motivation to make the suggested combination, and no expectation of success if such combination were made." (Remarks, page 13, top paragraph), the Examiner notes that Applicants' admitted prior art and Birchall are both directed to the same field of invention, i.e., an anchor coating to promote adhesion between a film substrate and superstrate. As such, Applicants' admitted prior art and Birchall are combinable. The idea of combining them flows logically from their having been individually taught in the prior art. See MPEP § 2144.06. Further, Applicants appear to be arguing the cited references individually. In response to Applicant's arguments, it is asserted that one cannot show non-obviousness by attacking references individually where the rejections are based on combinations of references. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981); *In re Merck & Co.*, 800 F.2d 1091, 231 USPQ 375 (Fed. Cir. 1986).

With respect to Applicants' argument that "The Examiner has provided no technical or factual grounds for any assertion that the use of an adhesion promoting layer with the substrates and superstrates of Birchall would necessarily result in improved cohesive strength at the surface of one of the layers. The improved results are therefore not inherent in Birchall." (Remarks, page 13, bottom paragraph), the Examiner notes that Applicants' argument is not persuasive since it assumes that an anticipation rejection, not an obviousness rejection, has been made. It should also be noted that Applicants' admitted prior art and Birchall teach all the elements of the invention as claimed, and that the properties of the instantly claimed invention are believed to be either inherently disclosed or an obvious optimization to one of ordinary skill in the art of anchoring layer.

For newly added claims 34 and 36, the Examiner repeats (see Paper No. 6, page 4) that Birchall expressly teaches that the intermediate coating layers are often referred to as 'anchor' coatings and are derived, for example, from an isocyanate-ended polyurethane resin, a phenol-formaldehyde resin or a vinylidene chloride - alkyl acrylate copolymer resin (column 22, lines 5 to 14).

For newly added product-by-process claims 35 and 37, the Examiner notes that the method limitations have not been shown on the record to produce a patentably distinct article, as such the formed articles are rendered *prima facie* obvious. It should be noted that product-by-process claims are product claims and that to be limiting in a product claim, a process limitation must be evidenced as effecting the structure or chemistry of the resultant product over the prior art. Further, the burden of proof for this

Application/Control Number: 09/916,116  
Art Unit: 1771

Page 5

showing is on Applicant after the Examiner presents an otherwise *prima facie* rejection.  
See MPEP § 2113.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Victor S Chang whose telephone number is 703-605-4296. The examiner can normally be reached on 8:30 - 5:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Terrel H Morris can be reached on 703-308-2414. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9310.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0661.

VSC

DANIEL ZIRKER  
PRIMARY EXAMINER  
GROUP 1300

1700

*Daniel Zinker*